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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,841	08/23/1999	Britta Daume	6887	9106

7590

04/15/2003

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EXAMINER

LUEBKE, RENEE S

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/491,841

Applicant(s)

Daume

Examiner

Renee S. Luebke

Art Unit

2833



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 26, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30, and 39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30, and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

1. In view of the Brief on Appeal filed on February 26, 2003, and reconsideration of the claims, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Upon consideration of applicant's arguments in the Appeal Brief, the claims are seen to define over Cuaderay, et al. and Tinnerman. Although the examiner, even now, finds that all of the claimed elements are disclosed and still disagrees that either of these references are non-analogous or teach away from the invention, applicant's arguments that there is no reason to combine the references are convincing.

3. Claim 25 is objected to because "said elastic sleeve part" lacks antecedent basis.

4. Claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 13 and 24 do not properly describe the invention. Contrary to section (c) of claims 1 and 13, the band shaped contact element is not *attached* to the base. As

noted on page 17 and 18 of the specification, the base 4 comprises the band shaped contact element 10 and the elastic part 22. The band is *part* of the base. It is further noted that claim 8 requires the base be constructed of a conducting material; the only way that his claim can be met by the present invention is if the band is part of the base. Many of the dependent claims, particularly claim 24, also confuse the relationship between the base, the band shaped contact element and the elastic part.

To the extent that the claims are understood, the following rejection, based on the prior art, applies.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22, 24, 25, 29 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellinwood (US Patent 2,279,866). This device (see Figs. 5-8) comprises a base structure 10, 13 "adapted to be tensioned around a coaxial cable," sealing lips (the edges of cushion 13 that project – as in the area of reference numeral 13 in Fig. 7) "for providing a seal," and a band shaped, electrically conducting contact element 10 including a metallic contact protrusion 14. In regard to claims 22 and 29, the ends of the base structure have brackets or terminals 11 that are connectable to a conductor. In regard to claim 39, it is noted that the brackets are "provided with sealing surfaces" and are "adapted to sandwich an elastic sealing element therebetween" since they are flat surfaces; no seal is positively claimed.

7. Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellinwood. In regard to claim 23, Ellinwood discloses the use of a screw 12 to attach the

brackets. The use of more than one screw is seen to have been an obvious duplication of parts. In regard to claim 26, Ellinwood discloses that the elastic part be formed of resilient rubber or other similar resilient and compressible material. One of average skill in the art would have concluded that a thermoplastic elastomer meets those requirements and would have seen such as an obvious alternative.

8. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellinwood in view of Tinnerman '627. Ellinwood is silent about how the screws are held to the bracket. However, Tinnerman teaches the use of a threaded bracket thereby reducing the number of required parts and securing the screw to the bracket prior to attachment. Therefore, it would have been obvious to use a threaded hole on the bracket of Ellinwood as taught by Tinnerman.

9. **Any response to this action may be mailed to:**
Assistant Commissioner for Patents
Washington, DC 20231

Effective May 1, 2003, the United States Patent and Trademark Office has a new Commissioner for Patents address. Correspondence in patent related matters must now be addressed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

For additional information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

or faxed to:
(703) 872-9318 or 308-7722 or 308-7724
(informal or draft communications should be clearly labeled "PROPOSED"
or "DRAFT")

Hand-delivered responses should be brought to:

Crystal Plaza 4, Fourth Floor (Receptionist)
2201 South Clark Place, Arlington, Virginia.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mrs. Paula Bradley, can be reached at (703) 308-2319.



Renee S. Luebke
Primary Patent Examiner
April 11, 2003



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